



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,819	02/22/2002	Edward O. Clapper	ITL.0694US (P13225)	3076

7590 10/20/2004

Timothy N. Trop
TROP, PRUNER & HU, P.C.
STE. 100
8554 KATY FWY
HOUSTON, TX 77024-1841

EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/081,819	Applicant(s) CLAPPER, EDWARD O.	
	Examiner Olisa Anwah	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 15-22 and 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 23-30, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2645

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 9-12, 14, 23-29 and 39 are rejected under 35 U.S.C. § 102(e) as being anticipated by Windsor et al, U.S. Patent No. 5,734,706 (Windsor).

Regarding claim 23, Windsor discloses a method comprising:

receiving in a first system (34) a search query (168 from Figure 4D) for information associated with a second party during a telephone call, the first system comprising a portable device

Art Unit: 2645

separate from a telephone and connectable to a telephone (26)
line or a computer (col. 12, line 1-5);

obtaining the information from the system if it is present
in the first system (174);

searching at least one remote source for the information if
it is not present in the first system (col. 11, line 36 and
lines 60-65);

providing the information to the first system from the
remote source (col. 11, lines 45-50).

While the computer system 34 of Windsor is not wireless,
the computer system is portable because it is capable of being
carried or moved about.

Regarding claim 24, see abstract.

Regarding claim 25, see col. 11, line 66.

Regarding claim 26, see col. 11, line 52.

Regarding claim 27, see col. 11, line 30 to col. 12, line

10.

Regarding claim 28, see col. 3, line 2.

Regarding claim 29, see col. 11, line 30 to col. 12, line

10.

Art Unit: 2645

Regarding claim 39, see col. 11, line 30 to col. 12, line 10.

Claim 9 is rejected for the same reasons as claim 23.

Regarding claim 10, see col. 9, lines 20-30.

Regarding claim 11, see col. 11, line 30 to col. 12, line 10.

Regarding claim 12, see col. 11, line 30 to col. 12, line 10.

Regarding claim 14, see col. 3, lines 1-5.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 30 is rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor in view of DeFazio et al, U.S. Patent No. 5,940,484 (hereinafter DeFazio).

Art Unit: 2645

Regarding claim 30, Windsor teaches the plurality of remote sources includes a remote service provider (col. 11, lines 60-65). Windsor fails to teach the plurality of remote sources includes the Internet. However DeFazio discloses this limitation (col. 3, line 51). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Windsor with a method wherein the remote source includes the Internet. This modification would have modernized Windsor by retrieving ANI information from a plurality of databases as suggested by Windsor and DeFazio.

5. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor in view of Brenner et al, U.S. Patent No. 6,206,593 (hereinafter Brenner).

Regarding claim 38, Windsor teaches a printer for printing caller identification information (50 from Figure 2). Windsor does not teach the printer is housed in the portable device. However Brenner discloses this limitation (see Figures 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26 and 27). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Windsor with the printer taught by

Art Unit: 2645

Brenner. This modification would have simplified the design of Windsor by saving precious desk space.

6. Claim 13 is rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor in view of Szlam et al, U.S. Patent No. 5,675,637 (hereinafter Szlam).

With respect to claim 13, Windsor does not teach the storage stores a user preference table that indicates a preferred search hierarchy among a plurality of databases. However Szlam discloses this limitation (col. 5, lines 10-15). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Windsor with the search hierarchy taught by Szlam. This modification would have improved the efficiency of Windsor by allowing information to be quickly retrieved from a plurality of sources as suggested by Szlam (column 1).

Response to Arguments

7. Applicant's arguments been considered but are deemed to be moot in view of the new grounds of rejection.

Art Unit: 2645

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.
Olisa Anwah
Patent Examiner
October 14, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

